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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,023	04/12/2002	Ian L Brown	28053/37955	6243

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EXAMINER

FONDA, KATHLEEN KAHLER

ART UNIT PAPER NUMBER

1623

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,023

Applicant(s)

BROWN ET AL.

Examiner

Kathleen Kahler Fonda, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-5-01 prel amdt.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicant will note that the cover sheet for this Office action indicates that the priority document has not been received from the International Bureau. Australian application PQ 6733 04/06/2000 is not in the file. The Examiner is attempting to obtain a copy of the missing document from the International Bureau.

Applicant is advised that claims 34 and 35 are improper multiple dependent claims under 37 CFR 1.75(c) because they do not depend from other claims in the alternative. See MPEP § 608.01(n). Applicant may wish to address this problem along with the response to the present restriction requirement in order to avoid a refusal by the Examiner to treat these claims at the time of the first Office action on the merits.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10, 26-33, and 35, drawn to methods for regulating carbohydrate and fat metabolism; enhancing fat

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metabolism or utilization; reducing plasma leptin concentration and increasing satiety; treating an individual suffering from obesity; lowering the incidence or risk of obesity; lowering the incidence or risk of non-insulin dependent diabetes mellitus; reducing post-prandial glucose and/or insulin levels; and controlling an individual's body mass.

Group II, claims 11 and 12, drawn to a method of preparing a foodstuff.

Group III, claims 13-25, 34, and 36-38, drawn to a composition comprising at least 2 g of resistant starch and at least 2 g of unsaturated fat, wherein the resistant starch is at least 5% by weight of the total starch content, and to a method of preparing such a composition.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons. The composition of resistant starch and unsaturated fat as recited in claim 13 cannot be a corresponding special technical feature because it does not represent an advance over the prior art. The oatmeal cookie batter disclosed in Example VI of EP 0 747 397 A2 meets the limitations of claim 13. For simplicity of calculations, assume 100 g of batter. This would be a

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very small amount for an actual batch of cookies, so the "at least" limitations of claim 13 would certainly be met by a batch of normal size. There would be 6% or 6 g of test starch, which is the total starch content of the batter. If butter is used, there would be 5.5 g of unsaturated fat. If ordinary 80% fat stick margarine is used, there would be 12.7 g of unsaturated fat. If 70% vegetable oil margarine spread is used, there would be 11.1 g of unsaturated fat. Regardless of which of these is used for the "butter or margarine" ingredient, there would be "at least 2 g of unsaturated fat" as required by claim 13. The calculations are set out in the following paragraph.

The Examiner used the USDA National Nutrient Database for Standard Reference, Release 15 (August 2002) to determine the total amount of unsaturated fat in butter, 80% fat stick margarine, and 70% vegetable oil margarine spread. The internet pages accessed are noted as reference U on the accompanying PTO Form 892, and copies are enclosed.

calculation for butter

total unsaturated fat	=	monounsaturat	+	polyunsaturat
		23.426	+	3.012
		26.4 g		

unsaturated fat in 100 g of batter

$$21 \text{ g butter} \times (26.4 \text{ g unsat fat} / 100 \text{ g butter}) = 5.5 \text{ g unsat fat}$$

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calculation for 80% fat stick margarine

total unsaturated fat	=	monounsaturat	+	polyunsaturat
		37.201	+	23.097
		60.3 g		

unsaturated fat in 100 g of batter

21 g marg X (60.3 g unsat fat/100 g marg) = 12.7 g unsat fat

calculation for 70% vegetable oil margarine spread

total unsaturated fat	=	monounsaturat	+	polyunsaturat
		36.733	+	16.299
		53.0 g		

unsaturated fat in 100 g of batter

21 g marg X (53.0 g unsat fat/100 g marg) = 11.1 g unsat fat

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see <http://www.uspto.gov/ebc/index.html> for more information. Also, <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm> may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30 a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.



Kathleen Kahler Fonda, Ph.D., J.D.
Primary Examiner
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